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Cases of Note - Commercial Appropriation

Bruce Strauch

The Citadel, strauchb@citadel.edu

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Questions & Answers

from page 77

the library or anyone else may reproduce them, convert the format, etc. It might be a good idea to examine the films carefully to make sure there is no copyright notice. It is possible that they were actually produced for the FAA by a government contractor which actually does hold the copyright. Changing the format of a public domain work does not create any new copyright in the underlying work. It remains in the public domain.

QUESTION: *There is a video produced by the BBC in 1988 called "Race for the Double Helix." It is out of print but available used through several vendors. The BBC will not respond to the library's request for permission to make a copy. Various offices respond that they are not the one responsible and cannot help. If the library makes every effort to get permission and fails, must it purchase a used copy or could it make a copy from a loaner?*

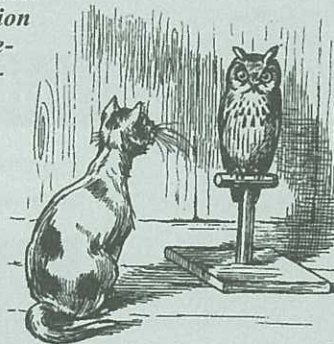
ANSWER: The question omits some critical information. Did the library once own the tape which has now been destroyed or damaged; is this an acquisitions question? If it is the former, Section 108(c) applies. The library may duplicate the tape from a loaner after it makes a reasonable effort to find an "unused" copy at a fair price. In other words, it may replace the lost or damaged copy but only if new copies are no longer available.

On the other hand, if the library is trying to acquire something it has never had in the collection, the Copyright Act provides no permission to reproduce the tape at all. Thus, purchasing a used copy may be the only way to lawfully acquire the video.

QUESTION: *One of the public libraries in the system is located near the Emily Dickinson homestead, and it has a significant collection of material about her and her work. The library has copies of a number of dissertations. Researchers frequently ask the library to copy entire dissertations for their use. Academic libraries in the area have a variety of practices they follow, but most have a reference copy and a circulating copy of the dissertations created at their institutions. Some do reproduce the dissertations and charge for the copy. As degree granting institutions, do they have some rights to the material?*

The practice here has been to refer the public library and its requestors to UMI's Dissertation on Demand service because none of the librarians is uncomfortable recommending that anyone copy anything in its entirety. Are dissertations different?

ANSWER: Most universities require graduate students to sign some sort of release that gives the library the right to hold the dissertation and use it to fill interlibrary loan requests. If ILL results in making a copy, there is not much problem since the release signed by the student author grants this permission. However, if the release or agreement from the student author says that the library may lend only the original or not reproduce the dissertation, then even the degree granting institution has no right to copy it for researchers.



QUESTION: *May a corporate library archive and put its Internet searches on the company Intranet? If the library conducts a search and downloads it to a library hard drive, archives it on one company server and then emails the results to a patron, there are now three copies of the material. Is this a problem?*

ANSWER: The term "Internet searches" indicates that the search really involves material on the open Web or digital products for which the company has a license. For licensed material, the terms of the license agreement control what use may be made of search results. Material on the Internet is copyrighted just as it is in print.

Reproducing the material widely and putting it even on an Intranet raises copyright concerns. If putting the searches on the Intranet means simply putting the question and then the url's where the information was found, this is no problem. It is the reproduction of the copyrighted work that is of concern.

Normally making one copy for a user is permitted under Section 108(d) but multiple copying is not permitted. Having works accessible by multiple users within the company counts as multiple copying. However, if the copies are "transitory" and are destroyed as soon as the patron has received the results, there is no problem. But if the library is indeed making three copies and retaining them, it should seek permission. 🐱

Cases of Note - Commercial Appropriation

by **Bruce Strauch** (the Citadel) <strauchb@citadel.edu>

SURF NEKKID or You Should be So Lucky

Yes, those lusty lads and lassies at Abercrombies are at it again.

George Downing, Paul Strauch, Rick Steere, Richard Buffalo Keaulana, Ben Aipa, Mike Doyle, Joey Cabell v. Abercrombie & Fitch 2001 U.S. App. LEXIS 20377 (9th Cir. 2001).

The long string of names are of course **surfer dudes** among whom we find one of the illustrious **Strauchs** of this world.

Abercrombie is that famous outfitter that loves to use hunks and hunkettes to peddle shirts, khakis, jeans and outerwear. Its subscription catalog "Abercrombie and Fitch Quarterly" (Quarterly) is a national mini-scandal that uses 80% of the company's ad budget. This sex-oozing 250 page tome has

seasonal themes, photos of hot models, stories, news and editorial.

In 1998, **Abercrombie** held a photo shoot at **Old Man's Beach, San Onofre Beach, Calif.** While there, they purchased photos of the above **dudes** from surf photographer **LeRoy Grannis** for \$100 each. Said photos had originally been snapped at the 1965 **Makaha International Surf Championship in Hawaii.**

Thus making the surfers into fairly old dudes as the Strauch who authors this fabulous column was only a senior in high school in that year. And I can guarantee you he's old.

Abercrombie put together the Spring 1999 Quarterly, "Spring Fever", with a section called "**Surf Nekkid**" and a 700-word

story "**Your Beach Should Be This Cool.**" **Old Man's Beach** was described, not **Hawaii**. But the story was illustrated with the **dudes** — names captioning the pics — in **Hawaii**.

Two pages later featured ads for "**Final Heat Tees**", shirts based on what the **dudes** were wearing in the **Hawaiian** competition.

The **dudes** saw this as a **commercial misappropriation** of their names and likenesses and sued.

It's not stated in the facts whether there were nekkid models. It's only way down in the opinion that you learn that — gasp — there were!

Abercrombie won in the district court on summary judgment and **dudes** appealed to

continued on page 79

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Cases of Note from page 78

the Ninth Circuit. The review was de novo. *Botosan v. Paul McNally Realty*, 216 F.3d 827, 830 (9th Cir. 2000).

Viewed in the light most favorable to the nonmoving party, was there a genuine issue of material fact? Well, let's find out.

First Amendment Issues

The district court found the use of photos and names was expression protected by the Constitution. Ninth Circuit said no way.

The common law grants a right of privacy for a person's name. *Eastwood v. Superior Court* 149 Cal. App. 3d 409, 416 (Ct. App. 1983).

To sue you must show a use of person's name that accrued to the defendant's advantage commercially or otherwise (!) and a lack of consent. Id. at 417.

California has layered this with a statutory remedy for the same under California Civil Code § 3344. This neither replaces nor codifies the common law and addresses the use of someone's name for advertising. Cal. Civ. Code § 3344(a). Plaintiff must prove the common law elements and show defendant knew what he was doing.

This is balanced by the use of a name "in the public interest, which rests on the right of the public to know and the freedom of the

press to tell it." *Montana v. San Jose Mercury News, Inc.*, 34 Cal. App. 4th 790, 793 (Ct. App. 1995). This protects "almost all reporting of recent events," and "people who, by their accomplishments, mode of living, professional standing or calling, create a legitimate and widespread attention to their activities." See *Eastwood*, 149 Cal. App. 3d at 422.

Abercrombie relied on *Dora v. Frontline Video, Inc.*, 15 Cal. App. 4th 536 (Ct. App. 1993) which held a surfing documentary in the public interest because it recorded "a certain time and place in California history and, indeed, in American legend." Id. at 543. Surfing legend Mickey Dora was hacked off about being used in that one, but the court wrote:

"... surfing is of more than passing interest to some. It has created a life-style that influences speech, behavior, dress, and entertainment, among other things. A phenomenon of such scope has an economic impact, because it affects purchases, travel, and the housing market (???). Surfing has also had a significant influence on the popular culture, and in that way touches many people. It would be difficult to conclude that a surfing documentary does not

fall within the category of public affairs." Id. at 546.

What a dry way to say it. What they mean is it ranks right up there with Demolition Derbies, Mud Wrestling, Tractor Pulls, Pie-eating Contests and Barbecue Cook-offs. It's AMERICAN by God, and we're proud of it!



The Ninth Circuit found a big distinction between a documentary on Mickey Dora and the use of the **dudes** "as window-dressing" to sell t-shirts. The dudes were not described as legends and were not connected to the story. The use of their images contributed little or nothing to any matter of public interest.

A note also distinguished our dudes from the famous **Dustin Hoffman** case where his "Tootsie" picture was digitally altered to appear in a current designer dress in L.A. Magazine's "Grand Illusions" article. There the 9th Cir. found First Amendment protection because L.A. Magazine had no connection to the gown designer and received no consideration. *Hoffman v. L.A. Magazine*, 255 F.3d 1180 (9th Cir. 2001).

Abercrombie placed the dudes right before "Final Heat Tees", making its use much more commercial.

continued on page 80

Cases of Note from page 79

Federal Copyright Preemption

Abercrombie said this was really a copyright issue and thus federal Copyright Act preempted state law.

"When acting within constitutional limits, Congress is empowered to pre-empt state law by so stating in express terms." *California Fed. Sav. & Loan Ass'n v. Guerra*, 479 U.S. 272, 280, 107 S. Ct. 683 (1987). Plus 17 U.S.C. § 301 says states are prohibited from legislating in the area of copyright.

Dude photos are pictorial works of authorship and protected by the Copyright Act. See 17 U.S.C. § 191 ("pictorial ... works include ... photographs.") But the squabble is not over the use of LeRoy Grannis' photos as creative works of authorship that's at issue. The fight is over the use of dude's names and likenesses.

The mighty **Nimmer** weighs in on the issue with:

"The 'work' that is the subject matter of the right of publicity is the persona, i.e., the name and likeness of a celebrity or other individual. A persona can hardly be said to constitute a 'writing' of an 'author' within the meaning of the copyright clause of the Constitution. A fortiori it is not a 'work of authorship' under the Act. Such name or likeness does not become a work of authorship simply because it is embodied in a copyrightable work such as a photograph." 1 Nimmer on Copyright § 1.01 [B][1][c] at 1-23 (1999).

Got that? What he's saying is "me, myself & I" is a persona — an identity — a "gosh I'm special" — and owned by me separate from any photo made of me.

Whether Grannis had properly conveyed his copyright interest in the photos for \$100 each is a separate thing.

The Fifth Circuit held the same distinction between misappropriation and copyright when a record company used names and likenesses of musicians and song writers on its CD's, catalogs and posters. See *Brown v. Ames*, 201 F.3d 654, 661 (5th Cir. 2000).

Likewise the California Court of Appeal in *KNB Enterprises v. Matthews*, 78 Cal. App. 4th 362 (Ct. App. 2000) in a case involving erotic photos put up on a website for profit and without permission.

Lanham Act

Dudes also brought a claim for trademark confusion under the Lanham Act which the district court nixed. The Ninth Circuit's holding in *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979) puts celebrity confusion on a par with any other commercial confusion.

As the confusion question is factual in nature it's a pretty natural jury question. *Wendt v. Host Int'l, Inc.* 125 F.3d 806, 812 (9th Cir. 1997).

Confusion factors to consider:

1. level of recognition of plaintiff in society for whom defendant's product intended

Surf historian Steve Pezman says the dudes "are considered legends in the surf community and are still highly well-known and regarded." Making it likely the dudes would be known to the Abercrombie target audience.

2. relatedness of the fame to the product

Dudes are famous because they're surfers. Abercrombie is selling "Final Heat Tees."

3. similarity of likeness used to the plaintiff

Of course it was photos of them.

4. evidence of actual confusion

Dudes submitted declarations of folks who believed dudes were endorsing Abercrombie products

5. marketing channels used

There was only one - the Quarterly.

6. likely degree of purchaser care

Surf apparel buyers could reasonably be seen by a jury as not real careful.

7. defendant's intent on selecting the plaintiff

Jury could find Abercrombie set out to feign an endorsement.

Now just when you think the district court has flubbed the whole thing, we get to the last issue.

Defamation

Dudes claimed shame and embarrassment at being in a section of the Quarterly with nude and scantily clothed models.

Can you believe they said that with a straight face?

To win this, they must show (1) libelous on its face, or (2) special damages. Libelous on its face means the viewer can figure it out without explanatory matter. Cal. Civ. Code § 45a.

Which given that they weren't nekkid or posed with the nekkid models means you'd have to tack on an explanation that the dudes while clothed in the competition photos were frequently nekkid après surf.

But the opinion doesn't say that. Instead it deals with three declarations from "surf industry leaders" and says they don't ad-

continued on page 81

Biz of Acq — Developing Book Donation Resources

by **Paul T. Jackson** (Information, Library, and Organizational Consultant, Trescott Research, Information & Library Development) <trescott@umich.edu>

Column Editor: **Michelle Flinchbaugh** (Acquisitions Librarian, Albin O. Kuhn Library, UMBC, 1000 Hilltop Circle, Baltimore, MD 21250; Phone: 410-455-6754; Fax: 410-455-1598) <flinchba@umbc.edu>

Column Editor's Note: For libraries with limited resources, gifts are often an important source of materials. **Paul T. Jackson**, as the Library Director of a new prison library in Lapeer, Michigan, developed a library collection almost completely through gifts, acquiring 22,000+ books in three to four years time, with a budget for only 200 books per year. In this article, he shares the expertise he developed on locating and procuring free materials for his collection. **Paul** has been involved with the start-up, organization, and development of ten libraries (including archives, col-

lections, or library-related organizations). His article is taken from a book he is outlining on "Building a Library," intended for those faced with starting-up libraries. — **MF**

When I joined the opening of the brand new prison in Lapeer, MI, in 1987, as Library Director, I was confronted with the task of not only erecting the shelving but ordering and receiving enough books to keep the 500 prisoners, already arriving, with reading materials. The \$25,000 start-up money for the library disappeared and I was eventually able to order about \$3,000 worth of books, primarily expensive reference works. I needed to find sources of donations. Certain law books that were required under a 1983 consent decree were furnished by the state. But there were additional law books needed for certain types of law research that were not provided.

continued on page 81

Cases of Note from page 80


dress whether average people would find it defamatory. But it doesn't give us the declarations.

Whoaaa! I mean, like, this is really shameful, man. We have to ask ourselves here, what would the Big Kahuna do?

Special damages are "all damages which plaintiff alleges and proves that he has suffered in respect to his property, business, trade, profession or occupation, including such amounts of money as the plaintiff alleges and proves he has expended as a result of the alleged libel, and no other." Cal. Civ. Code § 48a(4)(b).

But dudes didn't lose any business.

And they weren't drummed out of Surfers for Jesus either.

But they were still in court on all the rest of it. 

Biz of Acq from page 80

Local Library Book Sales

Many unsold books are sold off by the bag or warehoused for the next sale, or given to other organizations. Often by agreement with the library another library can come in and take a van or truckload for free—sometimes because volunteers aren't able to move them or store them.

I knew the local library was having a book sale, and I was able to load up my van after the sale with some of the items left that I felt would be appropriate. The friends of the library allowed me to later go to the place where they stored books for their annual sales and pick out another load. Later on, another library found out that I would come and pick up what they didn't sell. I think I may have picked up two or three vanloads at that library. I continued to do this, and once was able to get three truckloads from a university. We brought them in, found what we wanted and sent the others to other prisons, for there were many duplicates of the "good stuff."

It is possible that a library could develop exchanges of these after the sales books, so as to make the next one more interesting. After the sale pick-ups allows one to garner interesting materials that might fill a gap or two in anyone's collection.

For our law library, we sent letters to local and district courts asking for donations from participating lawyers. We received some gifts of sets from retiring lawyers or lawyers moving in with or merging with other practices. One such gift was the entire set of *American Law Review (ALR)*, and we only had to update a few volumes.

We also sought grants from the **Prisoner's Benefit Fund** for specific materials the prisoners had requested, and updating some of the gift multiple volume sets.

By the end of the fourth or fifth year we had to turn down some offers of some donations as we were continuing to be inundated by gifts from other sources we had developed.

I suspect there are angels or corporate officers that might substitute for grants from foundations or resources like the library grants **LSCA (Library Services & Construction Act)** usually offered through the state libraries. We did use the latter and were successful twice and once again with one of the Department of Education grants. Altogether grants amounted to about \$25,000 over the course of six years. Grants were not as satisfying as gifts; they took enormous amounts of time and energy.

Bookstores

Vanloads of books seemed nice, but did not meet all of our needs. We were given the green light to solicit bookstores. I knew that while there is a demand for remainders (books that didn't sell and are given up for reselling by "remainder" houses and catalog sellers like **Barnes and Noble**), there are many books that are not returnable to the distributors.

Our contact directory was an earlier edition of this book: *Book Publishing Resource Guide*, 5th edition, by Marie Kiefer. Ad Lib Publications, Fairfield, IA, 1996.

Both retail and college book stores are a source of newer book donations for the following reasons:

1. They can deduct from tax liabilities full market value of the donation instead of (if discarded) only the cost of the item. Some mass paperbacks are shorn of their covers and

the covers scanned for barcodes and reported as returned and the books are dumped in the dumpster. In other words, it is too expensive to return, but if they aren't accounted for royalty will have to be paid.

2. Books may not be returnable to distributors, but are not selling and taking up space needed for newer titles.

3. New editions have come out and the old one takes up space and are often not a saleable item, but for some reason are not discarded nor taken off the inventory, creating a tax liability in some states.

4. Stores (Academic) may change texts when a new professor arrives, leaving old texts to be stored, sold at a loss, or dumped.

5. Shipping books back to the distributor or publisher is expensive and, while given credit, the distributors also take back credit in the form of a restocking charge (read accounting charge, as most of these are either shipped back to the publisher directly or destroyed by the retailer), enabling a donation to be more cost effective.

One can direct inquiries to individual bookstore managers. Sometimes they ask that you come get them and sometimes they will ship them, and sometimes without first notifying you which may be a problem if you rely on a warehouse and POs (Purchase Orders). Some books had arrived that we were unaware of simply because the warehouse didn't know where to direct them. We were very successful with this program. Often I would go to bookstores and locate old editions of perhaps a *Writers Market*, or a music book, directory or such things, and note them, then back at the office the next day, have our clerk write a letter to the store. I suspect that

continued on page 82

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